

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 49-57 and 59-68 are pending in the application, with claim 49 being the sole independent claim. Claim 58 is sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claim 68 is sought to be added. Support for new claim 68 can be found throughout the specification, for example, at page 10, lines 15-18 and at page 13, lines 15-18. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

I. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 49-67 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Office Action at page 3.

The Examiner first asserted that the terms "desired" and "capturing" in claim 49 render the claim ambiguous and indefinite. *Id.* With respect to the term "desired," Applicants note that the currently presented claims do not include this term. Thus, this aspect of the rejection has been fully accommodated.

With respect to the term "capturing," Applicants respectfully disagree with the Examiner that this term renders the claim ambiguous and indefinite. Based on the ordinary meaning of the term "capturing," in light of the teachings of the specification (*see, e.g.*, specification at page 13, line 10 through page 16, line 4), a person of ordinary skill in the art would clearly appreciate what is meant by this term in the context of the method of claim 49. Thus, the term "capturing" does not render claim 49 indefinite.

In addition, Applicants note that no explanation has been provided as to why the term "capturing" is believed to render claim 49 indefinite. According to the MPEP, when rejecting a claim under 35 U.S.C. § 112, second paragraph, "an analysis as to why the phrase(s) used in the claim is 'vague and indefinite' should be included in the Office action." M.P.E.P. § 2173.02. No such analysis has been presented in the present Office Action with respect to the term "capturing." Applicants therefore respectfully request that the rejection under 35 U.S.C. § 112, second paragraph, insofar as it relates to the term "capturing" in claim 49, be reconsidered and withdrawn.

Finally, claim 58 was rejected under 35 U.S.C. § 112, second paragraph, based on the phrase "said desired circular target nucleic acid molecules are double stranded DNA molecules." Office Action at page 3. Claim 58 has been cancelled, thereby rendering this basis of rejection moot.

II. Obviousness-Type Double Patenting

Claims 49-67 were rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 5, 7, 11, 15-17, 20-27, 29, 32, 36

and 37 of U.S. Patent No. 5,759,778. Office Action at page 4. Claims 49-67 were also rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 and 17-20 of U.S. Patent No. 5,500,356. Office Action at page 6.

Applicants respectfully disagree with the reasoning set forth in the Office Action at pages 4-7 to support these rejections. Nevertheless, solely to expedite allowance of the present application, Applicants submit herewith a terminal disclaimer over U.S. Patent Nos. 5,500,356 and 5,759,778. Thus, the rejections for obviousness-type double patenting have been fully accommodated and should be withdrawn.

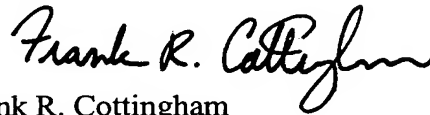
Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, reading "Frank R. Cottingham". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

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